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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/990,500

11/21/2001

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03/25/2011

EXAMINER

DANIELS, ANTHONY J

ART UNIT

PAPER NUMBER

2622

MAIL DATE

DELIVERY MODE

03/25/2011

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 09/990,500	Applicant(s) WASULA ET AL.	
	Examiner ANTHONY J. DANIELS	Art Unit 2622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 January 2011.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 21-25,27,28,31 and 32 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 21-25,27,28,31 and 32 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. The amendment, filed 11/11/2011, has been entered and made of record. Claims 21-25,27,28,31 and 32 are pending in the application.
2. Applicant's amendment to claim 27 has overcome the examiner's rejection under 35 U.S.C. 101.

Response to Arguments

Applicant's arguments regarding claims 21 and 22 and the Safai reference have been fully considered but they are not persuasive.

Applicant argues with respect to the Safai reference, "...the rejection first uses the term "e-mail address" as analogous to the claimed "image utilization fields." In this regard, it states "the computer must access the email address to send the images to the correct email address." (Claim 22 further illustrates the point that the e-mail address is being equated to the claimed "image utilization files.") Then, later in the rejection, it states that "if a voice message is checked, the images are modified in that a voice message will be attached with them. '" However, this reading required by the rejection completely misses a limitation which is not taught by the cited prior art. More precisely, the claimed invention "modifies each transferred image file in accordance with the set of image utilization fields." However, since the rejection equates the "e-mail address" to the claimed "image utilization fields," the rejection must then show the images are modified "in accordance with the e-mail address." However, this is not the disclosure of the

Art Unit: 2622

cited prior art as the rejection states the modification ("voice mail attached") but completely overlooks the fact that this modification MUST be done in accordance with the "image utilization files" or the purported "e-mail address" in Safai." The examiner submits that in the same manner the voice message modifies the images, the email address modifies the image file. More specifically, the email address modifies the image file in that it is attached to the transferred images. Also, the email address dictates where, in the external device, the images will be saved. Contrary to Applicant's argument that it is not the disclosure of the prior art that the images are modified in accordance with the email address, Safai states, in Col. 13, Lines 50-53, "The transport application sends the selected photos to the server 601, along with addresses entered by the user and any associated voice message, in digital form..." The examiner further submits that interpreting the email address as an image utilization field is reasonable when considered in light of the specification. Specifically, Figure 3A of the present application shows a plurality of image utilization fields, one of which includes a destination field indicating where the images will be stored. It is unclear how Applicant can disqualify Safai's email address as an image utilization field while the present specification explicitly describes a substantially similar one. Lastly, the examiner would like to note a particular statement in the BPAI Decision of Appeal for this case submitted on 3/29/2010, "We find no error in the Examiner's conclusion (Arts. 14) that images transferred to the external device in Safai '469 would be modified by having an attached voice message, and would be located in a directory defined by an e-mail address entered in the "To" address field 468 as illustrated in Figure 4F." (p. 12, lines 6-10)

Claim Objections

Claim 27 is objected to because of the following informalities: On line 2, “stored” should be storing. Appropriate correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 21-24,27,28 and 32 are rejected under 35 U.S.C. 102(e) as being anticipated by Safai (US # 6,167,469).

As to claim **21**, Safai teaches a method for transferring customized image files stored in a memory of a digital camera (Col. 12, Lines 63-67) to an external device (Col. 8, Lines 61-67; {External device is the computer that the email which contains the images is checked.}) having an external device database (Figure 6), using a camera database having at least one customizable profile containing a set of image utilization fields (Col. 12, 63-67; Col. 13, Lines 1-6), comprising the steps of:

(a) transferring a plurality of image files from the memory to the external device (Col. 6, Lines 5-12);

(b) accessing the set of image utilization fields (The computer must access the email address to send the images to the correct email address.});

- (c) modifying each transferred image file in accordance with the set of image utilization fields (Figure 5, {If a voice message is checked, the images are modified in that a voice message will be attached with them.});
- (d) storing the modified transferred image file in the external device (Figure 4F, To: “468”); and
- (e) updating the camera database and the external device database so that both the camera database and the external device database include the same profiles (Figure 4E, Send button “458”; {Sending the image profile makes the profile be stored in the external device and the camera database.}).

As to claim **22**, Safai teaches the method according to claim 21 wherein the set of image utilization fields is stored on the external device (It is inherent that the words gwang@photoaccess.com are stored in the external device.).

As to claim **23**, Safai teaches the method according to claim 21 further including the step of editing the customizable profile in the external device (After sending, it is inherent that the message is no longer available.).

As to claim **24**, Safai teaches the method according to claim 21 wherein the image utilization fields include a deletion field and further including the step of deleting the transferred image files from the memory in accordance with the deletion field after storage of such image in the external device (Figure 4F, Delete Pictures after Sending “474”).

As to claim **27**, Safai teaches a computer program product comprising a computer storage medium storing a computer program having instructions therein for causing the external device to perform the method of claim 21 (Col. 8, Lines 15-27).

As to claim **28**, the limitations of claim 27 can be found in claim 21 (a). Therefore, claim 27 is analyzed and rejected as previously discussed with respect to claim 21.

As to claim **32**, Safai, as modified by Kuba, teaches the method of claim 21 wherein the external device is a network service provider (Col. 6, Lines 5-19).

Claim Rejections - 35 USC § 103

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. Claim 25 is rejected under 35 U.S.C. 103(a) as being unpatentable over Safai (US # 6,175,003) in view of Roberts et al. (US # 6,496,222).

As to claim **25**, Safai teaches a method according to claim 21. The claim differs from Safai in that it requires the image utilization files include an image editing preference application software field designating a software application stored in the external device and further

Art Unit: 2622

including the step of applying the designated user preferred application software to the modified transferred captured image.

In the same field of endeavor, Roberts et al. teaches an image utilization field which includes an image editing preference application software field designating a software application stored in the external device and further including the step of applying the designated user preferred application software to the modified transferred captured image (see Figure 14A, “APPLE V1”, “IBM V2”; Col. 12, Lines 16-35). In light of the teaching of Roberts et al., it would have been obvious to one of ordinary skill in the art to modify include in the image utilization fields of Safai an image preference application software field. The modification of including a software application program field would allow the user to avoid erroneous image transfer due to incompatibility with the right software application program (see Roberts et al., Col. 12, Lines 37-42).

2. Claim 31 is rejected under 35 U.S.C. 103(a) as being unpatentable over Safai (US # 6,175,003) in view of Kuba et al. (US # 5,806,572).

As to claim **31**, Safai teaches the method of claim 21. The claim differs from Safai in that it requires the set of utilization fields include a filename suffix or filename prefix appended to the camera filenames.

In the same field of endeavor, Kuba et al. teaches a filename suffix appended to the camera filename (see Figure 60, suffix “J6C”). In light of the teaching of Kuba et al., it would have been obvious to one of ordinary skill in the art to include a filename suffix appended to the names of the camera filenames of the image files of Safai. Such modifications would allow for

Art Unit: 2622

the user to easily specify compression type; consequently, allowing for faster transmission of images.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ANTHONY J. DANIELS whose telephone number is (571)272-7362. The examiner can normally be reached on 8:00 A.M. - 5:30 P.M..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sinh Tran can be reached on (571) 272-7564. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2622

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Anthony J Daniels/
Examiner, Art Unit 2622

3/23/2011